



Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

INTF-35691US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on August 4, 2006

Signature [Signature]

Typed or printed name Steven J. Solomon

Application Number

10/806,643

Filed

March 23, 2004

First Named Inventor

Jeffrey J. Schroeder

Art Unit

1771

Examiner

Hai Vo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number Reg. No. 48719

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

[Signature]
Signature

Steven J. Solomon

Typed or printed name

216-579-1700

Telephone number

August 4, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Claim 47 stands rejected for indefiniteness (Section 112), and for obviousness over Pollock in view of Hasegawa and the "Dynamat" article.

Regarding indefiniteness, the Examiner's position is the claim is indefinite because the preamble recites a "heat shield," and the body of the claim specifies the heat shield is "mounted to a body panel of an automobile." It is believed there is no indefiniteness. Clearly, the heat shield that is claimed is mounted to an automobile body panel. The preamble does not limit the claim structure, but merely identifies the general nature of what is being claimed. It is believed the person skilled in the art will easily understand the scope of the claimed structure.

As to obviousness, claim 47 (the only independent claim) is now rejected based on Pollock as a base reference, with Hasegawa being used as a secondary reference to teach a foam having the claimed properties, and Dynamat being used as a secondary reference to teach adhering the claimed structure to an automobile body panel. First, applicant notes the Dynamat article is not a proper reference, at least because no date for this reference has been established. The Dynamat article has a copyright notice that says "© 1991-2005 Dynamic Control of North America, Incorporated." It is not clear what date should be applied to the specific page cited by the Examiner. For example, portions of that page may have been published at different times. Alternatively, the copyright notice may apply to the entire webpage as a whole, and the specific page printed by the Examiner may be only recent. The range 1991-2005 falls partially before the earliest priority date for the present application (June 3, 2003), and partially after. Because it is unclear exactly what portion(s) of the page cited by the Examiner may have been published before or after that date, the page is not a proper reference, and it cannot be used to reject features of applicant's claim. Still further, a copyright notice may identify when a work is created, and not necessarily when it is published or made available to the public. For this reason as well, the copyright notice by itself is not sufficient basis on which to establish the date of the 'reference' for prior art purposes.

Even apart from the improper use of the Dynamat article, the rejection is still considered inappropriate, and constructed based on hindsight reasoning. In the last Amendment, dated March 1, 2006 (cert. of mailing), applicant argued that Pollock is not an appropriate reference in this case because a person of skill in the automobile damping/heat shielding art would not even consider a patent describing an insulating layer for a duvet, which is an article of bedding.

Bedding articles and automotive heat shields are manufactured to vastly different tolerances, with vastly different properties, and no one would consider them remotely related, or that one may be used when addressing problems with the other. In response, the Examiner stated Pollock discloses that the described insulating layer can be used "in other domestic or industrial situations...." Pollock, col. 3 lns. 15-20. Based on this sentence in Pollock, the Examiner then points to Dynamat to suggest using the Pollock insulating layer over an automobile engine would have been obvious, because Dynamat discloses using a material to shield engine heat. Having thus established the complete structure in claim 47 (heat shield structure attached to automobile body panel) in the prior art, the Examiner next points to Hasegawa to describe a foam composition "similar to" that in the application, and to argue that consequently the properties recited in claim 47 would be inherently present in the foam of Hasegawa.

This tortuous path taken by the Examiner to teach or suggest all of the limitations, in combination, present in claim 47 demonstrates the hindsight basis for making the proposed reference combinations. Moreover, it is not believed the single sentence from Pollock that mentions "other domestic or industrial situations" would provide any independent motivation to look to Dynamat, or any other car-reference, as the Examiner has suggested. Pollock is clearly directed to a duvet insulation layer. The sentence noted by the Examiner, or one like it, is commonly added to patent applications so that the claims that issue from them will not be narrowly construed during litigation. But in truth, there is no reasonable basis to expect a person of ordinary skill in the automotive damping/heat shield art would even be able to find this duvet reference (Pollock) if he were looking to produce an automotive heat shield structure. Certainly, it would not be found in any library in the same section as materials directed to automotive shielding applications. It is important to remember that an automotive engineer looking to solve an automotive problem would look in the automotive literature, which would not lead him to the Pollock patent. Although Pollock's mention of "other domestic or industrial situations" may be interesting to a bedding producer, it almost certainly would never be seen by an automotive engineer.

Who would even consider a duvet cover as remotely suitable, or even that it might be made suitable, for use in automotive heat shielding applications, where point source temperatures may approach 1000°F or more? The single sentence in Pollock cited by the Examiner does not

change this fact. All that sentence really is useful for is to indicate to a reviewing court that the patentee did not intend his claims to be construed as limited to a duvet. It does not convey much to the person of ordinary skill in the automotive shielding art, if for no other reason than that such a person would almost certainly not even find the Pollock patent when addressing how to better thermally insulate an automotive underbody and dampen low-frequency road noise.

Claim 47 recites that the heat shield is "fastened or mounted to a body panel of an automobile" precisely because Pollock does not disclose such a structure, and there would be absolutely no reason (or even any expectation of being able) to modify the duvet insulation layer in Pollock so that it would be suitable for an automotive shielding application. The combination of references assembled by the Examiner does not fairly reflect what a real-world engineer might do, or where (s)he might realistically look, to address the thermal-insulating and noise-attenuating problems that are addressed by the present invention. The question of patent obviousness asks whether a person of ordinary skill in the art would fairly consider the claimed invention obvious in view of what is known in the relevant art. This question does not ask whether some combination of references can be found to disclose all the claim limitations, irrespective of whether that skilled person would ever see them, or dream of combining them.

Lastly, it is pointed out the last Office action was the fourth substantive Office action. This invention has been searched numerous times, and numerous bases of rejection have been levied. Therefore, it is respectfully submitted the relevant art has been thoroughly and carefully searched by the Examiner. Accordingly, should the panel determine the remaining art-based rejections are to be withdrawn, it is respectfully requested that the application be allowed, and not reopened for further prosecution. It is believed any further searching the Examiner may undertake would be merely redundant or duplicative of the efforts she has already carefully made, and of the numerous references already of record.

Should it be determined the art-based rejections are to be withdrawn but the indefiniteness rejection is to be maintained, the applicant will gladly authorize an Examiner's amendment to claim 47 as necessary to overcome the indefiniteness rejection to expedite allowance of this case.